

REMARKS

Claims 1, 2, 4, 8, 11, 12, 17, 20-24, 31-35, 37, 38, 40, 41, and 43-46 are pending, with claims 1, 33, 35, 37, 38, 40, and 46 being independent. Applicants request that the double patenting rejections be held in abeyance until the claims are otherwise held allowable.

The Examiner has rejected claims 1, 4, 8, 11-12, 17, 20-23, 31-35, 37-38, 40-41, and 43-46 as obvious over Lennox in view of Irion and further in view of Grossi, claim 2 as obvious over Lennox in view of Irion and Grossi and further in view of Rosar, and claim 24 as obvious over Lennox in view of Irion and Grossi and further in view of Nardella.¹

Each of the independent claims recites that the electrically conductive surface has at least a portion recessed in or projecting from the flat, non-conductive surface. Irion teaches away from the use of electrodes having projections or recesses as claimed, and one of ordinary skill in the art, presented with Irion, would not modify the electrode of Lennox to include such projections or recesses.

Irion describes “an electrode for HF surgery, and particularly for vaporising tissues, that comprises an electrode body rolling over the tissue and suitable to achieve a certain distribution of current density.” (Irion, col. 1, lines 35-40). Irion’s electrode has a body formed with a smooth surface formed by filling recesses between electrically conductive projections with an electrically insulating material. (Irion, col. 3, lines 33-50).

Not only does Irion teach that its electrode has a smooth surface, it specifically teaches away from electrodes having either projections or recesses formed on the surface of the electrode. For example, in the “Background of the Invention,” Irion describes an electrode that employs projections on its surface and states that “[i]n a number of cases, however, a penetration of the electrode body into the tissue is *undesirable*.” (Irion, col. 3, lines 11-24) (emphasis added). See In re Fulton, 391 F.3d 1195, 1201 (Fed. Cir. 2004) (prior art that describes certain features as undesirable teaches away from claimed invention). Moreover, Irion discloses that electrode bodies provided with recesses rather than projections result in a number of

¹ The Examiner apparently meant to include Grossi in his rejections of dependent claims 2 and 24 even though the Office action did not specifically include the reference in the rejections.

disadvantages “in practical applications, such as a higher risk of injury due to the shoulders or recesses in which tissue fragments could ‘get caught’.” (Irion, col. 3, lines 24-35).

The Examiner's reliance on Irion for it being “well-known in the art” to make an electrically conductive surface either recessed in or projecting from a flat, non-conductive surface is unfounded. When read as a whole with the remainder of Irion's specification, it is clear that Irion teaches away from a projecting or recessed conductive surface. W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1550-51 (Fed. Cir. 1983) (the totality of a reference's teachings must be considered). Indeed, Irion sums up this teaching away by stating that its smooth surface electrode achieves a certain distribution of current density “without occurrence of the disadvantages linked up with the use of projections or recesses, respectively.” (Irion, col. 3, lines 40-43). Such teaching away cannot be ignored when rejecting the claims as obvious.

Therefore, one of ordinary skill in the art, presented with Irion, would not modify the electrode of Lennox to arrive at the claimed invention. In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994) (holding that a reference teaches away when a person of ordinary skill, upon reading the reference, would be led in a direction divergent from the path that was taken by the applicant). Moreover, rather than considering the entire disclosure of Irion, portions of which clearly teach away from the claimed invention, the Examiner is impermissibly picking and choosing from Irion relying on hindsight of applicants' invention. KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1742 (2007) (factfinder should be aware of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning); In re Fritch, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”).

The Examiner has also relied upon Grossi, Rosar, and Nardella in rejecting certain claims. These references do not overcome the deficiencies in the references discussed above.

Thus, for the reasons discussed above, it is respectfully submitted that the Examiner has not established a prima facie case of obviousness as to independent claims 1, 33, 35, 37, 38, 40, and 46, or their dependent claims. Accordingly, all claims are in condition for allowance.

Applicants do not acquiesce in the Examiner's characterizations of the art. For brevity and to advance prosecution, applicants may not have addressed all characterizations of the art and reserve the right to do so in further prosecution of this or a subsequent application. The absence of an explicit response by applicants to any of the Examiner's positions does not constitute a concession of the Examiner's positions. The fact that applicants' comments have focused on particular arguments does not constitute a concession that there are not other arguments for patentability of the claims. Applicants submit that all of the dependent claims are patentable for at least the reasons given with respect to the claims on which they depend.

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Respectfully submitted,

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